



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/687,151	10/12/2000	John J. Sie	19281-000600US	8606
20350 7590 06/26/2008 TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834				
EXAMINER				
BROWN, RUEBEN M				
ART UNIT		PAPER NUMBER		
2623				
MAIL DATE		DELIVERY MODE		
06/26/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/687,151

Applicant(s)

SIE ET AL.

Examiner

REUBEN M. BROWN

Art Unit

2623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 17 April 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13, 21, 22 and 24-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13, 21, 22 and 24-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/C)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to the 103 rejection of the claims, relying on Proehl, in view of Garfinkle, filed 4/17/2008 have been fully considered but they are not persuasive.

It is noted that on page 8 of the response, applicant argues that the VOD of Garfinkle is the opposite of the claimed, linearly scheduled broadcast program, and thus apparently not applicable to the claims. First of all, the base reference Proehl clearly teaches at least storing short video clips that are related to linearly scheduled broadcast program(s), that may be requested by the consumer at a user terminal device, see col. 15, lines 1-19. However, the difference between Proehl and the claimed subject matter is that even though Proehl discloses that the short video clips could at least be still shots of the selected broadcast program, or related to the selected broadcast program; the reference does not explicitly discuss that the instant short video clips could be a *'first portion of the'* instant selected broadcast *'program'*, as presently recited.

Nevertheless, one of ordinary skill in the art is presented with the disclosure of Garfinkle, which teaches pre-storing a lead-in portion of program(s) that also may be requested by the consumer, (whereas the lead-in portion of Garfinkle corresponds with the short video clips disclosed in Proehl). Thus one of ordinary skill in the art would have been motivated to combine

the lead-in technique of Garfinkle, with the pre-storing of short video clips already disclosed in Proehl, at least for the benefit of allowing the customer an immediate start to a selected program, for instance, at least which overcomes a possible transmission delay that may occur, even in a scheduled broadcast, especially in a CATV or satellite system.

Applicant has argued that the system of Proehl does not suffer from latency issues. However, it is pointed out that all video transmission system are inherently susceptible to any number technical problems that may cause a delay in the reception of a requested linearly scheduled broadcast. For instance, there may be thousands of components between a CATV and subscriber, such as switches, routers, amplifiers, nodes, and thousands of feet of coaxial and/or fiber optic cable. Any one or a combination of components may cause a temporary disruption in service. Likewise it was well known in the art that satellite TV systems often suffer program disruption due to inclement weather that occasionally blocks the being signal sent from the satellite transponder to the instant subscriber terminal. Thus, it would have been obvious for one of ordinary skill in the art at the time the invention was made, to modify Proehl with the technique of pre-storing some video programs, at a subscriber terminal as taught by Garfinkle, which at least overcomes the program disruption problem discussed above.

Nothing in Proehl teaches against its modification by a VOD system. The programs broadcast by Proehl, are simply video programming which is generally video content stored at the headend that the consumer accesses by requesting a channel change and/or a specific request,

which is the same as the video content stored in Garfinkle. Except that the VOD in Garfield are only transmitted based on a demand from particular consumer(s).

In the recent KSR ruling, it has been determined that an obviousness rejection can be sustained given the following; (1) a finding that the prior art contained a “base” device (method, product, etc.) upon which the claimed invention can be seen as an improvement; (2) a finding that the prior art contained a “comparable” device that has been improved the same way as the claimed invention; (3) a finding that one of ordinary skill in the art could have applied the known “improvement” technique in the same way to the “base” device and the results would have been predictable to one of ordinary skill in the art.

To that end, it is asserted that when one of ordinary skill in the art is presented with Proehl which already comprises a memory/hard drive local to a consumer's TV receiving equipment for storing video clips, related to linearly scheduled broadcast programming, and Garfinkle which stores a beginning portion of certain programs also in the memory local to a consumer's TV receiving equipment, that one would expect to achieve a result of pre-storing beginning portions of certain linearly scheduled broadcast programs so that the consumer would receive the instant beginning portion of a requested movie from the locally stored memory, and the remaining portion delivered by the headend.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-13, 21-22 & 24-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Proehl, (U.S. Pat # 6,990,676), in view of Garfinkle, (U.S. Pat # 5,530,754).

Considering amended claim 1, the claimed method for receiving a program by a user location that is sent from a content distributor, comprising:

'receiving the program at the user location as a linearly scheduled program, which can be viewed on a channel', is met by the disclosure of Proehl that a user selects regular broadcast programming for display on the TV screen, see Abstract; Fig. 13A; Fig. 13B; col. 14, lines 26-67.

As for the claimed, *'processing and storing a first portion of the program at the user location'*, and *'detecting a user request for the program after storage of the first portion and receiving a second portion of the program in response to the user request'*, Proehl discusses that graphics images such as still shots from the instant program or short video clips related to the program, etc. may be downloaded and stored on the hard drive of the user's terminal equipment, Abstract; col. 15, lines 1-18. Proehl goes on to discuss that if the user selects a linearly scheduled

broadcast program that is currently being broadcast, that the system presents the user with the instant broadcast program. However, these graphics images, (such as short video clips) will be presented to the user when a linearly scheduled broadcast program is selected that is scheduled to be broadcast in the future from the current date/time, which is different from the recited claims.

Nevertheless, Garfinkle provides a teaching of, receiving and storing a lead-in segment of a movie/program in the catalog store memory 22 at a user site 18; see Fig. 1; col. 1, lines 54-67 thru col. 2, lines 1-12; col. 3, lines 5-32. In particular, Garfinkle teaches that after a viewer watches previews of various movies, the instant viewer may choose product, i.e., movie/program, which is generally stored at a central site. This full-length product is then transmitted to the viewer, col. 3, lines 10-14; col. 3, lines 65-67 thru col. 4, lines 1-12 & col. 5, lines 3-9. However, if the movie/ program that is selected by the user has a lead-in segment already downloaded to the user's site 18, then that lead-in segment is initially presented to the user, after which the remaining presentation is based on programming currently being transmitted, see col. 4, lines 19-21 & col. 4, lines 48-50. Therefore the combination of Proehl & Garfinkle meets the claimed subject matter.

The combination of Proehl & Garfinkle provides for the system to download short clips, such lead-ins for different programming services, such as linearly scheduled broadcast programs. Once a customer selects a particular broadcast program, then a lead-in segment is initially played from the user's terminal equipment, with the remaining portion coming from the regular broadcast. It would have been obvious for one of ordinary skill in the art at the time the invention

was made, to modify Proehl with the feature of presenting the first portion of a program from downloaded segments, at least for the desirable advantage of overcoming any hiatus created by time consumed in any downloading/transmission processing, as taught by Garfinkle, col. 1, lines 61-67.

As for the amended claimed feature of: *'wherein the first portion is at least one eighth of the program'*, Proehl only discusses images as "short clips", without examples of the duration, whereas Garfinkle discusses that the lead-in segment may be on the order of two minutes, col. 4, lines 21-35. Official Notice is taken that at the time the invention was made, access to larger memory units/cache was well known in the art. It would have been obvious for one of ordinary skill in the art at the time the invention was made, to modify the combination of Proehl & Garfinkle with the well-known technology of expanded memory capacity, which enables longer durations of the lead-in segments to be stored on the receiver, for example such as an hour or more, at least for the desirable improvement of expanding the time available for the system to transmit the rest of the program to the consumer.

Considering claims 2 & 11, if the viewer's home equipment has downloaded and stored a lead-in segment of the movie that the viewer has just selected, then the lead-in segment is retrieved from the catalog store 22, and begins to be displayed for the viewer; see Garfinkle, Abstract; col. 1, lines 64-67 & col. 4, lines 12-25.

Considering claims 3 & 12, the instant claims recite that a *'first time associated with playing the first portion is equal to or greater than a second time associated with receiving or transmitting a second or plurality of portions'*. Accordingly, Garfinkle discloses that "the lead-in" which is stored at a user location memory 22 and played when a user selects its corresponding video product (i.e., movie), "is an initial segment of the video product sufficient in length to allow the downloading of the selected product to the user site", see col. 4, lines 19-35. Garfinkle goes on to further explain that, "For example, the lead-in segment may be of the order of two minutes long. In order to provide a seamless transition or splice from the catalog stored lead-in to the full video program stored material downloaded...".

It is noted that the claims do not recite any restrictions regarding the length of the second portion itself, specifically as compared to the first portion. Therefore Garfinkle's disclosure that the lead-in segment is of sufficient length to allow the downloading of the selected product reads on the claimed subject matter. For instance, Garfinkle discusses that if the user terminal does not have enough memory to store the entire movie, that the instant movie is transmitted in segments; col. 5, lines 14-22. The first transmission is only as much as the user terminal can store. When a certain number of minutes of the movie remain that have not been played from a particular segment, then the system transmits the next segment. Therefore the time needed to playback a downloaded portion of the movie is longer than the time for downloading the next portion of the movie.

Considering claim 4, the claimed subject matter reads on the operation of the remote controller 14 of Proehl, which used infrared technology, col. 9, lines 52-64.

Considering claims 5 & 13, the programs in Garfinkle that include a lead-in segment read on the recited programs consisting of a first and second portion; col. 4, lines 12-67. Thus, the combination of Proehl & Garfinkle meets the claimed subject matter.

Considering claim 6, the claimed set-top box reads on the integrated receiver 12 of Proehl, Fig. 1; col. 4, lines 15-67 & col. 5- col. 7.

Considering claim 7, the claimed mass storage device reads on the HDD 228 of Proehl, col. 6, lines 1-35; col. 15, lines 1-18.

Considering claim 8, the claimed feature of determining a subset of programs from a linear schedule of programs and dividing each of the subset of programs into a respective first and second respective portion reads on the server in Garfinkle periodically transmitting the lead-in segments for any group of movies, col. 2, lines 1-12; col. 4, lines 45-58. It is disclosed that lead-ins are only generated for 'certain products', which reads on '*determining a subset of programs*'. The additionally claimed feature of transmitting a plurality of the respective first portions to the user location is also met by the above-cited disclosure of Garfinkle and col. 3, lines 5-17.

Considering claim 9 Garfinkle teaches that a certain of the programs at a central station 10, have lead-in segments, which in combination with Proehl, reads on the claimed '*determining a linear schedule of content programs, wherein each content comprises a first segment and a second segment*'; see col. 2, lines 1-8.

The additional step of storing a second set of segments remotely from a user location reads on col. 4, lines 35-46, which discusses movies being housed in a product store 12 of the central station 10. The additionally claimed features of, '*transmitting and storing a first set of segments to the user location, and transmitting one of the second set of segments to the user location, after a request from the user*' is met by col. 3, lines 1-30; col. 4, lines 12-35 & Fig. 5.

As for the amended claimed feature: '*wherein the first segment is at least fifteen minutes*', represents a logical extension of the subject matter found in claim 1, and is likewise analyzed.

Considering claim 10, the claimed feature of transmitting a commercial to the user location reads on the disclosure of Garfinkle of downloading trailers or previews to the subscriber; col. 2, lines 1-6; col. 4, lines 9-12.

Considering claims 21 & 22, the claimed features correspond with subject matter mentioned above in the rejection of claims 1 & 9, and are likewise treated.

Considering claims 24 & 26, the claimed method '*wherein the first and second sets are transmitted with different media chosen from the group consisting of multicast media & singlecast media*', reads on the combination of the references, since the linearly scheduled programming of Proehl meets 'multicast' and the downloaded lead-in segment of Garfinkle meets 'singlecast'.

Considering claim 25, the claimed subject matter is also met by the combination of Proehl & Garfinkle.

Considering claim 27, the claimed, '*plurality of portions*' is broad enough to read on the program, in digital form, comprising a plurality of portions of a transport stream, whereas Proehl teaches that the programming may be transmitted as an MPEG video, col. 10, lines 10-18 & col. 15, lines 9-18.

Considering claim 28, the combination of Proehl & Garfinkle plays the lead-in segment, and then the remaining program, which meets the claimed subject matter.

Considering claim 29, it would have been obvious for one of ordinary skill in the art, at the time the invention was made, to operate Proehl & Garfinkle in a manner such that both of the portions of programming comes from the same channel, at least for the known advantage of avoiding the consumer, possibly having to re-tune the TV system to a different channel, in order to receive the second portion.

Considering claim 30, the claimed features correspond directly with subject matter mentioned above in the rejection of claims 1, 3, 9 & 24, and are likewise treated.

Conclusion

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any response to this action should be mailed to:

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

or faxed to:

(571) 273-8300, (for formal communications intended for entry)

Or:

(571) 273-7290 (for informal or draft communications, please label
"PROPOSED" or "DRAFT")

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Reuben M. Brown whose telephone number is (571) 272-7290. The examiner can normally be reached on M-F(8:30-6:00), First Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Kelley can be reached on (571) 272-7331. The fax phone numbers for the organization where this application or proceeding is assigned is (571) 273-8300 for regular communications and After Final communications.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Reuben M. Brown
/Chris Kelley/
Supervisory Patent Examiner, Art Unit 2623